REMARKS

Claims 27, 28, and 32-59 are pending. Claims 27 and 59 have been amended.

Rejection of Claims under 35 U.S.C. §112

The Examiner rejected claims 27, 28, 32-34 and 59 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner rejected claim 27 for failing to include all of the limitations of the base claim and any intervening claims. While Applicants submit that the claims as previously presented included all the limitations, and that there is no requirement for word-for-word amendment, Applicants have amended claim 27 to replace the word "if" with the word "when", as suggested by the Examiner.

The Examiner rejected claim 59, since it is not clear whether it depends from claim 23 or claim 56. Applicants have amended claim 59 to delete the erroneous reference to claim 23 identified by the Examiner.

Accordingly, Applicants submit that amended claims 27 and 59 are now compliant with 35 U.S.C. §112, second paragraph, and respectfully requests that the rejections of these claims, as well as the rejections of claims 28 and 32-34 depending from claim 27, be withdrawn.

Rejection of Claims under 35 U.S.C. §102(a)

Claims 35-41, 44 and 52-59 are rejected under 35 U.S.C. §102(a) as being anticipated by Abreu et al. However, with respect, Abreu fails to teach all of the limitations of the claimed invention, as is required for an anticipation rejection.

Claim 35 of the present application includes the limitation of "counting a number of times the system channel is lost within a timeout period". Abreu does not disclose counting a number of times the system channel is lost within a timeout period. None of the counts disclosed by Abreu is limited by "a timeout period". The counts disclosed by Abreu are arbitrary numbers of times that some property of a channel is unacceptable. Thus, the limitation of a timeout period in claim 35 provides a distinct advantage over Abreu. As stated at paragraph 31 of the disclosure of the present application: "The timeout period establishes a second condition for entering the deep sleep mode in combination with the first condition. In other words, the deep sleep mode is entered only when the pilot or paging channel is lost at least a minimum number of times within a maximum period of time." Therefore, a level of

sophistication is present in the method of claim 35 which is not found in Abreu, and withdrawal of the rejection under 35 U.S.C. §102(a) is requested. Since claims 36-41, 44, and 52-55 depend from, and include the limitations of claim 35, Applicants respectfully request that the Examiner's rejection of these claims under 35 U.S.C. §102(a) also be withdrawn.

In addition, claim 36 of the present application includes a limitation, that "the step of re-entering the deep sleep mode includes switching the mobile device to one of a first, second and third level deep sleep modes." Abreu does not disclose a third level deep sleep mode. In the passage cited by the Examiner in support of the rejection, Abreu teaches that "After repeated unsuccessful scans, the sleep time will change to a longer duration to further conserve power in the battery" (column 8, lines 38-41). Applicants submit that this passage may support a second level deep sleep mode, but not a third level deep sleep mode. Furthermore, a third level deep sleep mode cannot be inferred by interpreting the passage as a recursive method, since any reading of the cited passage as a recursive method would eventually yield impractically long sleep times – a commercially useless result that could not have been contemplated by Abreu, since it would prevent a portable device embodying the invention of Abreu from coming back online within a useful amount of time once service is restored. This would be especially impractical in situations where a mobile device is moving, since coverage may become available suddenly. Therefore, Abreu does not teach all of the limitations of claim 36, and withdrawal of the rejection under 35 U.S.C. §102(a) is requested. Since claims 37-41 and 52-55 depend from and include the limitations of claim 36, Applicants respectfully request that the Examiner's rejection of these claims under 35 U.S.C. §102(a) also be withdrawn.

Furthermore, claim 56 of the present invention includes the limitation of "a low power controller for iteratively sampling an RF condition parameter at a time interval defined by the deep sleep mode variables and for providing the control signals to the variable setting controller when the RF condition fails to improve". The disclosure of Abreu merely teaches that "When the sleep time ends, the handset 120 will again scan for a suitable base station." Therefore, the teachings of Abreu require that the handset itself be used to scan for a suitable base station, presumably at full power, and do not specify that this scan should be carried out by "a low power controller". Consequently, Applicants submit that Abreu fails to teach all the

limitations of claim 56, or its dependent claims 57-59, and request that the Examiner's rejection of these claims under 35 U.S.C. §102(a) be withdrawn.

Rejection of Claims under 35 U.S.C. §103(a)

Claims 42 and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Abreu in view of Sklovsky (U.S. Patent Application 2004/0041538A1). The Examiner has also rejected claims 45-51 under 35 U.S.C. §103(a) as being unpatentable over Abreu in view of Sasaki (US Patent 5,539,858).

For the Examiner to establish a prima facie case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.).

With respect, each of the rejections under 35 U.S.C. §103(a) fails on at least the third of these criteria. In view of the arguments made above with respect to Abreu, it is clear that Abreu does not teach or suggest all of the limitations of claims 36 and 37, from which claims 42, 43 and 45-51 depend.

Sklovsky does not teach the use of a third level sleep mode. Sklovsky's teachings are directed to the conservation of power in situations where battery power is low (paragraph 22) and not to the conservation of power in situations where it would be advantageous to enter a sleep mode due to the absence of a system channel. Claim 42 includes the limitation of "a first system list, a second system list, and a third system list associated with the first, second and third sleep modes respectively." Since Sklovsky does not teach sleep modes and since neither Sklovsky nor Abreu teach either a third sleep mode or a list of systems associated with each sleep mode, the combination of Sklovsky and Abreu fails to teach or reasonably suggest the limitations of claim 42. Furthermore, since Sklovsky is not directed to situations where a signal is absent, it is submitted that there would be no motivation to combine the teachings of Sklovsky with the teachings of Abreu, since they

address different problems. Sklovsky addresses the problem of power conservation in situations where a signal is present, and not situations where no suitable system is available.

The Examiner has rejected claim 43 as obvious in view of Abreu and Sklovsky, and cites paragraph 29 of Sklovsky in support of the allegation that Sklovsky teaches that "the first system list is a subset of the second system list and the third system list, and the second system list is a subset of the third system list". As noted above with respect to claim 42, from which claim 43 depends, Applicants submit that Sklovsky contains no teaching of any lists of systems. Furthermore, Applicants submit that even those lists that Sklovsky does disclose, such as lists of functions, or lists of proposed battery saving modes, are not subsets of system lists associated with sleep modes, since Sklovsky does not disclose sleep modes either. Therefore, the combination of Abreu and Sklovsky cannot teach or suggest the limitations of claim 43.

Accordingly, Applicants respectfully requests that the Examiner's rejections of claims 42 and 43 under 35 U.S.C. §103(a) be withdrawn.

The Examiner has rejected claims 45-51 under 35 U.S.C. §103(a) as being unpatentable over Abreu in view of Sasaki. The Examiner alleges that, although Abreu does not teach that the step of comparing includes setting a mobility flag to true if a Pseudo Noise of the system is unknown, Sasaki does teach this. Applicants respectfully disagree, since Sasaki merely teaches that a comfort noise (CN – column 4, line 5) flag is used in determining whether or not a pseudo noise signal is played to a user in order to enhance their comfort level. Therefore, the combination of Abreu and Sasaki fails to teach or suggest the limitations of claim 45.

Furthermore, Applicants respectfully submit that the Examiner has engaged in forbidden hindsight analysis in applying Sasaki in the rejection of claim 45. In order to prevent hindsight analysis, there must be some motivation or suggestion to combine specific prior art in such a way as to arrive to the combination disclosed in the patent at issue. See, e.g., Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc., 231 F.3d 1339, 1343 (Fed. Cir. 2000): "*the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test of obviousness.*", and

Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d at 1371-1372 (Fed. Cir. 2000), "*Combining prior art references without evidence or a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.*" Applicants submit that the teaching of Sasaki addresses a problem that is non-analogous to the problem addressed by the invention of the present application, namely ergonomics. Sasaki plainly teaches an invention that addresses the discomfort felt by the user of a radiotelephone in the absence of background noise, and that the solution to this problem is the introduction of a pseudo noise signal in the absence of genuine background noise. The purpose of Sasaki is not the conservation of power in a sleep mode in the absence of a suitable system channel, or even the conservation of power in general. Applicants submit that there would be no motivation whatsoever to combine Sasaki with the teachings of Abreu and accordingly requests that the Examiner's rejections of claims 45-51 under 35 U.S.C. §103(a) be withdrawn.

Applicants submit that in view of the amendments to the application, and the foregoing arguments, the application is in condition for allowance and earnestly solicits action to that end.

The Commissioner is hereby authorized to charge any additional fees, and credit any over payments to Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP.

Respectfully submitted,
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